REMARKS

The Examiner has rejected independent claims 1 through 22 under 35 U.S.C. §103 on the new grounds. The independent claims have been voluntarily amended in this response to clarify the subject matter of the current invention for removing indefiniteness. No new matter has been added by the current claim amendment, and the scope of the claims remains substantially identical. In view of the above claim amendment and the following remarks, the Applicant respectfully requests the Examiner to reconsider the pending rejections.

The Section 103 Rejections

The Examiner has rejected claims 1, 2, 12 and 22 under 35 U.S.C. §103 as being unpatentable over Holleran et al. in view of Taylor et al. The Examiner has also rejected claims 3, 4, 10 and 11 under 35 U.S.C. §103 as being unpatentable over Holleran et al. and Taylor et al. and further in view of Krishnaswamy et al. The Examiner has rejected claims 5 through 9 under 35 U.S.C. §103 as being unpatentable over Holleran et al., Taylor et al. and Krishnaswamy et al. further in view of Ouchi. Lastly, the Examiner has indicated the rejection bases of claims 13 through 21 correspond to those of claims 1 through 12 and 22.

Independent claims 1 and 12 explicitly recite "the newly generated address definition including some components based upon the corresponding predetermined rule definition and the corresponding conditions ...." Independent claims 21 and 22 similarly recite "the newly generated address definition including some components based upon the corresponding predetermined rule definition and the corresponding condition." In other words, a new address is "automatically" generated according to a predetermined rule and a predetermined condition.

DOCKET NO.: RCOH-1044   **PATENT**
Application No.: 10/057,046
Response to Office Action of May 30, 2007
Amendment dated August 28, 2007
Page -9-

For rejecting independent claims 1, 12, 21 and 22 based on a new combination of the previously cited prior art references, the Examiner has combined Holleran et al. and Taylor et. Al.

In this regard, the Holleran et al. reference discloses an apparatus for depicting an electronic mail address in either a filed format or a string format. As described with respect to pairs of Figures 6B and 6C, Figures 8 and 9, Figures 11a and 11b as well as Figures 12a and 12b, the same address is shown either in the filed format or the string format. The string format shows the address information in an unformatted way. On the other hand, the field format shows the same address in a predetermined formatted way. For example, Figure 11a illustrates the format style by displaying "Pat Holleran" and "3rd Floor" in the two predetermined units of information as name and zone. On the other hand, Figure 11b illustrates the string style by displaying "PatHolleran@3rd Floor," which is generated from the same information without any conditional limitation.

The Examiner has conceded in Paragraph 6 of the currently pending Office Action that the Holleran et al. reference "fails to teach generating a new address definition based upon the corresponding conditions at the second device, the newly generated address definition including some components based upon the corresponding predetermined rule definition and corresponding conditions." For the lack of the necessary disclosure, the Examiner has cited the Taylor et al. reference.

In general, the Taylor et al. reference discloses an integrated system for electronic mail, facsimile transmission, terminal emulation and file synchronization among distributed computers. An electronic address book allows information to be efficiently sent to users of both electronic mail and facsimile transmission. To optimize the communication, five types of address cards are implemented to include a person card, a group card, a computer card, a calling card and a service card. For example, the person type address cards hold personal and destination information about a specific person or

entity. Similarly, the group type address cards hold group/personal and destination information about a specific person or group. The personal/group and destination information further include a list of "electronic mail addresses" as well as phone and fax numbers. The only existing mail addresses are stored, and no new mail addresses are "automatically" generated.

In his characterization of the second prior art reference, the Examiner has asserted that the Taylor et al. teaches both of the lacking disclosures in the Holleran et al. reference. For the lacking disclosure, "a new address definition based upon the corresponding conditions at the second device," the Examiner has alleged that the Taylor et al teach the same subject matter at line 52, column 23 through line 18, column 24. Similarly, for the lacking disclosure, "the newly generated address definition including some components based upon the corresponding predetermined rule definition and corresponding conditions," the Examiner has alleged that the Taylor et al teach the same subject matter at lines 19 through 40, column 24.

The Taylor et al. reference at line 52, column 23 through line 18, column 24 discloses how to "assemble pieces of the message, which collectively form the envelop, and create a package which conform to the format requirements of the communication service to which the package is intended" with respect to FIGURE 16. (lines 6 through 9, column 24). In regard to address, the Service type address card contains the user identification, the password and the telephone access number for an electronic mail. (line 66, column 23 through line 4, column 24). In contrary to the Examiner's characterization, the Applicant respectfully submit that the first alleged portion of the Taylor et al. reference thus fails to teach, disclose or suggest "a new address definition based upon the corresponding conditions at the second device."

By the same token, the Taylor et al. reference at lines 19 through 40, column 24 discloses methods including "GetAddressTemplate" and "MakePckage." In particular,

the "GetAddressTemplate" method only confirms the address format for the service provider. (lines 19 through 22, column 24). The "MakePckage" method receives (i) an array of items to be included in the package, (ii) a list of recipients, (iii) description, (iv) a message, (v) a list of attachment files and (vi) a time stamp. (lines 23 through 29, column 24). The "MakePckage" method prepares a communication package including the above in a format that is acceptable to a destination communication service. (lines 29 through 31, column 24). The rest of the cited portion discloses "DestroyData," "GetNote," "GetDistList" and "GetAttachments" methods for reversing the above packaging processes for obtaining a specified information from a package. (lines 32 through 40, column 24). Thus, in contrary to the Examiner's characterization, the Applicant respectfully submit that the second alleged portion of the Taylor et al. reference again fails to teach, disclose or suggest "the newly generated address definition including some components based upon the corresponding predetermined rule definition and corresponding conditions."

For the rejections of dependent claims, the Examiner has cited two additional prior art references in further combination of the above discussed prior art references. Namely, the Krishnaswamy et al. reference generally discloses systems and methods of routing and managing telephone calls, data and other multimedia information including audio and video through a switched network such as a Public Switched Telephone Network (PSTN) which includes transfer of information across the Internet. In managing the above system, a user profile information is stored, and the user information includes name, address, fax number, IP address and e-mail address as disclosed in column 27.

Furthermore, the Krishnaswamy et al. reference discloses "X. INTERNET TELEPHONY AND RELATED SERVICES" in columns 74 through 113. The communication in the Internet telephony includes connections between 1) PC to PC, 2) PC to PSTN, 3) PSTN to PC and 4) PSTN to PSTN. To manage these communication transactions, the user profile method is created based upon the information that is

gathered from individual users as disclosed in column 108. The information includes name, address, e-mail address and IP addresses that have been already generated before and stored elsewhere. The user must input the above information.

The Ouchi reference generally discloses a message-based workflow systems and methods for computer networks. By use of the e-mail based system, the Ouchi reference exemplifies a workflow of submitting, approving and reimbursing business expenses for predetermined projects. For each project, a predetermined set of e-mail addresses is assigned to perform the above exemplary tasks. For example, the approval task is performed by a predetermined singular manager or one of pre-assigned managers depending upon the employee who submits the request. In any case, the e-mail addresses are stored in advance for various employees, tasks and projects, and the predetermined rules or conditions simply determine to retrieve one of the previously stored e-mail addresses. In other words, the retrieved address is not "automatically" generated, but simply retrieved.

For the above reasons, even if the four cited references are combined in any manner, no teaching, disclosure or suggestion is provide based upon the combined cited references for the generation of a new address that is different from an existing one.

Dependent claims 2 through 11 ultimately depend from independent claim 1 and incorporate the patentable feature. Dependent claims 13 through 20 ultimately depend from independent claim 12 and incorporate the same patentable feature of independent claim 12. Thus, it would not have been obvious to one of ordinary skill in the art to provide the patentable feature of the independent claims based upon the four cited references alone or in combination. Therefore, the Applicant respectfully submits the Examiner to withdraw the rejections of claims under section 103.

<u>Conclusion</u>

In view of the above remarks and attachments, the Applicants respectfully submits that all of the pending claims are in condition for allowance and respectfully request a favorable Office Action so indicating.

Respectfully submitted,

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